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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,332	11/24/2003	Kazuhisa Takayama	60280 (70904)	6559
21874	7590	07/31/2006	EXAMINER	
EDWARDS & ANGELL, LLP			FALASCO, LOUIS V	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

1773

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,332

Applicant(s)

TAKAYAMA ET AL.

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

PAPER RECEIVED

1. Applicants' arguments and amendments filed May 09, 2006 are acknowledged.

CLAIMS

2. The claims are: 1 to 18.
3. Claims 17 and 18 have been withdrawn as non-elected. Applicant's election in the reply filed on 6/7/05 has been acknowledged in the previous action. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election is treated as an election without traverse (MPEP § 818.03(a)).
4. The claims under consideration remain: 1 to 16.

Claim Rejections - 35 U.S.C. §112 2nd paragraph, 102(a), 103(a)

Statutory Basis

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4, 5, 7, 8, 9, 11, 12, 14, 15 and 16 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Hirokane et al** (EP 1 098 306) for reasons of record.
6. Claims 2, 3, 6, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hirokane et al** (EP 1 098 306) for reasons of record.
7. Claims 1 to 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 and 22 to 31 of **Hirokane et al** US Patent No. 6678219 for reasons of record.

Examiner Response to Arguments

Applicants' arguments, filed May 09, 2006, have been fully considered but they are not persuasive.

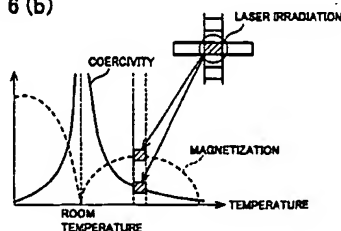
8. It is argued that **Hirokane et al** contrasts from the instant claimed invention by requiring the second magnetic layer to have a greater peak residual magnetization than the first magnetic layer. This has not been found convincing. **Hirokane et al**, while not specifying a residual magnetization, teaches second and the first magnetic layers having the *same* composition disclosed for the instant claimed second and the first magnetic layers. This is the same as that resulting in the second magnetic layer having a greater residual peak magnetization than the first magnetic layer. This *same* composition feature was pointed out in the previous Office action and has not been disputed by

applicants in the arguments filed May 09, 2006. Never the less the examiner appreciates that applicants have claimed the second magnetic layer *having a greater residual peak magnetization* than the first magnetic layer not explicitly disclosed by **Hirokane et al.** However with the same composition in the layers it is reasonable to assume that the same composition would have the same peak residual magnetization characteristics. *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). There is no requirement that a person of ordinary skill in the art recognized this inherency of the characteristics, but only that the subject matter is in fact inherent in the prior art. See *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003). Peak residual magnetization is a property of media having the same prior art composition and it is well established that the "Discovery of a previously unappreciated property of a prior art composition. . . does not render the old composition patentably new . . ." from *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). At the very least the burden shifts to applicants and there is no evidence to show the same peak residual magnetization characteristics would not be inherently present in **Hirokane et al.** *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

9. It is argued that **Hirokane et al** contrasts from the instant claimed invention by requiring a greater Curie temperature relative to layer 3. This has not been

found convincing. It was pointed out in previous action that greater relative Curie temperature was appreciated in **Hirokane et al** in order for the media to be laser-imaged and the stable at room temperature (also see **Hirokane et al** paragraphs [0041-45]). With regard to the processes that taking advantage of the relative Curie temperatures these are under specific *use* conditions (**Hirokane et al** paragraph [0041], [0051]). In use the first magnetic layer (layer 3) develops flux lines for recording in the second magnetic layer (layer 4) permitting the second magnetic layer to be imaged by the laser. This appreciated in **Hirokane et al**, e.g., paragraph [0019] and instantly disclosed, *cf*, instant Fig. 6(a) – illustrating magnetic goes through the first layer and magnetic pattern held in the second layer at the laser temperature. The square recording area illustrates the temperature of laser irradiation optimally occurs at highest magnetization point.

FIG. 6 (b)



Nonetheless, it is well established that an intended use for an article is given little weight in consideration of claims directed to an article. When a prior art product appears to be identical except as to an inherent characteristic in an intended use it may be properly rejected for obviousness under 35 U.S.C. 103 and anticipation

under 35 U.S.C. 102. See *in re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) and *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Additionally there is no requirement that a person of ordinary skill in the art recognize the inherent disclosure at the time of invention, only that it is in fact inherent. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003)

10. It is argued that **Hirokane et al** contrasts from the instant claimed invention by requiring a four layer structure and so does not teach the present (*sic*) claimed three layered structure. This has not been found convincing. The instant claims have not been limited to solely to the three layered structure argued. The instant claims are cast in 'open' language. The present transitional term "comprising" is open-ended and does not exclude additional, unrecited elements such as additional layers. *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004). The instant claim term "comprising" leaves the claim open for the inclusion of additional layers. *Gillette Co. v. Energizer Holdings Inc.*, 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005).
11. As regards the double patenting rejection, where portions of the disclosure of **Hirokane et al** US Patent No. 6678219 have been used to define the Patent claims: applicants have relied on arguments made over **Hirokane et al** EP 1 098 306 which correspond to US Patent No. 6678219. This has not been found

convincing. These arguments have been answered in paragraphs 10 through 12 above.

SUMMARY

The claims are 1 to 18.

- Claims 17 and 18 have been withdrawn from consideration
- Claims under consideration are 1 through 16.
- No claim has been allowed in this action.

THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis de Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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07/06


CAROL CHANEY
SUPERVISORY PATENT EXAMINER